

Appl. No. : 09/881,142
Filed : June 14, 2001

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Discussion of Claim Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

In the Office Action, the Examiner rejected Claims 3, 20, 26, 28-31, 35, and 38-40, under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,543,851, to Chang. The Examiner also rejected Claims 1, 2, 4-19, 21-23, 25, 27, 32-34, 36, and 37 as being unpatentable over Chang in view of U.S. Patent No. 6,748,375, to Wong, et al.

Applicants may overcome a § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references. M.P.E.P. § 715.02. Applicant submits herewith two Rule 1.131 *Declarations* and corresponding appendices to overcome Wong. The *Declarations* includes facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued (37 C.F.R. § 1.131(a)(1) and M.P.E.P § 715). The showing of facts are such, in character and weight, as to establish conception of the invention prior to the effective date of the referenced coupled with due diligence from a date prior to the effective date of the reference to a subsequent filing of the application (37 C.F.R. § 1.131(b) and M.P.E.P § 715).

The *Declarations*, by Paul Thomson and by Eric Nelson, show that the claimed invention was conceived by Mr. Thomson by at least September 6, 2000 in this country. Furthermore, the *Declarations* shows that Mr. Thompson and Applicant's representatives were diligent in constructively reducing the invention to practice by filing the application from at least September 6, 2000 to December 1, 2000, i.e., the filing of U.S. Provisional Application No. 60/250,835, a priority application for the above-referenced application. These facts establish that the inventors had conceived of the invention as early as September 6, 2000.

In light of the above, Applicant submits that Wong is removed from use as a reference for claim limitations and this removal enables patentability, even as under § 103. The *Declarations* by Paul Thomson and Eric Nelson show possession of the whole invention by the inventors as claimed prior to the effective priority date of Wong, i.e. September 6, 2000, and that there was

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reasonable due diligence through the application filing date. Since the inventor has demonstrated inventorship prior to Wong's filing date, Wong should be removed as a reference for claim limitations. Accordingly, it is submitted that Claims cannot be held as unpatentable under § 103. Applicant respectfully requests the withdrawal of all claim rejections under § 103 and the prompt allowance of the claims.

Notwithstanding the above, Applicant respectfully submits that the claims, as amended, are patentable over the current art of record. Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is described, either expressly or inherently in a single prior art reference. *See* M.P.E.P. § 2131. Furthermore, Applicant respectfully submits that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P § 2143.03. Applicant respectfully submits that the Chang fails to teach or suggest at least one limitation from each of the above-listed claims as amended.

Applicant respectfully submits that the Chang fails to teach or suggest at least one limitation from Claim 1, as amended. Chang discloses a system in which a user manipulates closed caption data and selects words for which a translation or a dictionary definition can be retrieved. Applicant submits that Chang does not disclose "transmitting the selected symbols to a database system," as was stated by the Examiner in the Office Action.

Applicant also respectfully submits that the Wong fails to teach or suggest at least one limitation from Claim 1, as amended. Applicant respectfully submits that Wong also does not disclose transmitting, via a network, the selected symbols to a database system that is external to the display, where the selected symbols were selected as a result of receiving, via the input device, the third control instructions to select at least one of the symbols. The symbols transmitted in Wong are automatically generated. Wong states: "[t]he present invention performs keyword extraction on the ASCII text to generate key words and/or terms which are employed by a search engine to perform a search on the Internet for content related to the broadcast." See column 3, lines 45-48.

Therefore, Applicant respectfully submits that the cited prior art, in isolation or in combination, fails to teach or suggest at least one limitation from Claim 1, as amended, and that Claim 1 is now in condition for allowance. Applicant further submits that at least for similar

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reasons as discussed above with regard to Applicants Claim 1, Applicants Claim 7, as amended, is now also in condition for allowance.

Applicant respectfully submits that Chang also fails to teach or suggest at least one limitation from independent Claims 3, 20, and 31. Independent Claims 3, 20, and 31 have each been amended to include a limitation of transmitting the selected symbols to a database system that is external to the electronic device. As stated in the Office Action, Chang “fails to specifically disclose transmitting the selected symbols to a database system.”

Since Chang fails to teach or suggest at least this limitation, Applicant respectfully submits that independent Claims 3, 20, and 31, as amended are patentable over Chang. Applicant further submits that since Claims 2, 5-6, 8-19, 22-30, and 32-40 each depend from one of independent Claims 1, 3, 7, 20, and 31, these claims are allowable for the reasons discussed above and the subject matter of their own limitations.

Summary

Applicant has endeavored to address all of the Examiner’s concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort